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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

03102.1020

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on August 23, 2010

Signature /Adam E. Crall/Typed or printed name Adam E. Crall

Application Number

10/646,150

Filed

08/22/2003

First Named Inventor

Sheldon H. Foss Jr

Art Unit

3684

Examiner

Elizabeth Rosen

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.
/Adam E. Crall/

Signature

☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Adam E. Crall

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Registration number if acting under 37 CFR 1.34 _____

August 23, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below.

☐ *Total of _____ forms are submitted.

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Sheldon H. Foss *et al.*

Confirmation No.: 8917

Group Art Unit: 3684

Serial No.: 10/646,150

Examiner: Elizabeth Rosen

Filed: 08/22/2003

Docket No. 03102.1020

For: System and Method for Dynamically Managing a Financial Account

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

In response to the Final Office Action mailed February 22, 2010, the Applicant respectfully requests panel review pursuant to the Pre-Appeal Brief Conference Pilot Program. 1296 Off. Gaz. Pat. Off. 67 (12 July 2005, extended 10 January 2006). A Notice of Appeal is filed herewith. This Request is filed with an accompanying Petition for 3-Month Extension of Time and a Notice of Appeal and, thus, is believed to be filed timely. The Applicant believes that pre-appeal review is warranted because the rejection of record is clearly improper and factually deficient. In the event that additional fees may be required, such fees are hereby authorized to be charged to Deposit Account No. 50-3479.

I. Status of Claims

Claims 1 – 4, 6, 8 – 11, 13, and 15 – 23 are pending in the present application. Claims 1 – 4, 6, 8 – 11, 13, and 15 – 23 stand rejected under 35 U.S.C. 112, first paragraph as allegedly failing to comply with the written description requirement. For purposes of this Pre-Appeal Brief Review Request, all rejected claims are grouped into a single category containing all pending claims.

II. Arguments

The Applicants respectfully submit that the rejection of claims 1 – 4, 6, 8 – 11, 13, and 15 – 23 under 35 U.S.C. 112, first paragraph is clearly improper. The Final Office Action argues that the recitation of a “processing system” is new matter, alleging that the specification does not include any description of the claimed invention being performed by a processing system. The Applicant respectfully disagrees.

The law under 35 U.S.C. 112, first paragraph is that a description as filed is presumed to satisfy the written description requirement, unless or until sufficient evidence or reasoning to the contrary has been presented by the Examiner to rebut the presumption that the written description requirement has been satisfied. *See In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The Examiner must have a reasonable basis to challenge the adequacy of the written description. The Examiner has the initial burden of presenting by a preponderance of the evidence why a person skilled in the art, at the time the specification was filed, would not recognize in the Applicant’s disclosure a description of the claimed invention. *See Wertheim*, 541 F.2d 263, 191 USPQ 91.

The Applicant respectfully submits that the Office Action has failed to overcome the presumption that the written description requirement has been satisfied. In fact, the Office Action merely provides conclusory statements and allegations – without the required evidence – that the description fails to suggest that the claimed invention is performed by a computer or processing system. The entirety of the discussion presented to rebut the presumption of compliance is on Page 3 of the Final Office Action. The Office Action acknowledges that the written description illustrates a processing system and a computer and such description clearly states that “[t]he James/Foss [inventors’] system is a collection of integrated computer softwares and proprietary algorithms ... that enable the analysis/issuance/distribution/monitoring of an integrated credit product that extends credit through host based stored value and an unsecured credit line.” This description and illustrations (cited by the Applicant as support for claim amendments submitted December 17, 2009) are present in the description on at least Page 17 of the appendix to the provisional application, to which the present application claims priority and forms part of the description. The Office Action argues, however, that this description does not suggest performing the claimed invention on a processing system or computer.

Nowhere in the Office Action is any factual evidence presented regarding the relevant issue -- why a person skilled in the art would not recognize that the inventors were in possession of "a processing system" performing the various claimed functions. The Office Action provides no reasonable basis for why a person skilled in the art would conclude that the processing system does not perform the various claimed functions described in the specification as encompassing embodiments of the invention. Absent such evidence and based merely on conclusory statements, the Office Action fails to establish a prima facie case for rebutting the presumption of compliance with the written description requirement.

In fact, the Applicant submits that a person skilled in the art would readily come to the opposite conclusion in view of at least the above-referenced description and illustrations. The Applicant states, under the heading "Preliminary Patent Definitions", that the [inventors'] system "is a collection of integrated computer softwares and proprietary algorithms." A person skilled in the art would readily recognize that the various features and functions embodied in the computer softwares and algorithms are performed by a computer, processor, processing system, or other processing device(s). Any person skilled in the art would appreciate this fact. Any suggestion to the contrary, would ignore or distort the general knowledge of one skilled in the art.

Furthermore, the illustration on Page 17 under the heading "Preliminary Patent Definitions", further clarifies that the inventive features and functions are implemented by a processing system. The illustration clearly shows that the functions (represented as boxes in the system) interface with a processing system. The additional drawings on Pages 18 – 21 illustrate further embodiments of computer software and algorithms for implementing the inventive system. Notably, the drawing on Page 18 includes the same subject matter (software components) as FIG. 2 of the present application. Moreover, the drawing on Page 19 illustrates a computer terminal connected to a backend processing system and databases via the Internet, further evidence of a processing system for performing the embodiments of the inventive functions. Accordingly, the preponderance of the evidence in connection with the above-referenced portions of the written description clearly support the conclusion that a person skilled in the art would recognize that the various claimed functions may be performed by a processing system. For at least this reason, the Applicant submits that the rejection is improper and, therefore, should be withdrawn.

Even assuming for the sake of argument that the Office Action has established a prima facie case, the Applicant respectfully submits that proper consideration of the entirety of the Applicant's disclosure supports only one conclusion – a person skilled in the art would readily recognize that the various claimed functions may be performed by a processing system. In addition to the evidence noted above, the Applicant submits at least the following additional evidence, each of which would be recognized by a person skilled in the art as possession of the feature of a processing system performing the claimed features:

(1) The specification of the present application clearly teaches, on Page 3, ll. 10 – 16, that the present invention may be utilized in Stored Value Systems currently deployed by credit card processing systems, and that the features and aspects of the present invention can be ported into a variety of systems and system/network configurations. A person skilled in the art would readily recognize that such systems include a processing system for performing the various features embodied in software.

(2) Figure 2 in the present application clearly illustrates that the various functional components are tied to a financial transaction network, and the specification states that the functional components comprise structures (Page 4, ll. 17 – 20). A person skilled in the art would readily recognize that the functional components in association with a financial transaction network may be performed by a processing system.

(3) Page 2 of the provisional application states that “[a]spects of the present invention are based on the Stored Value Card Systems that are currently deployed by several credit card companies” (including those described at the cited URL on Visa's website) and that “[t]he present invention provides a customization or modification to such systems.” A person skilled in the art would readily recognize that such systems include a processing system for performing the various features embodied in software.

(4) Page 1 of the appendix to the provisional application states that “a Visa branded transaction card ... will provide all of the transactional functionality of a Visa branded card but will be funded from the account owner's personal funds.” A person skilled in the art would readily recognize that such transactional functionality may be provided by a processing system for performing various features embodied in software.

(5) Pages 3 – 6 of the appendix to the provisional application describe systems requirements for embodiments of the invention including “web application requirements” and

“back-office requirements” that may vary based on “processor methodology.” A person skilled in the art would readily recognize that the web application, back-office components, and processor methodologies would include a processing system for performing the various described features.

For at least these additional reasons, the Applicant respectfully submits that the pending claims do not recite “new matter” and that they fully comply with the written description requirement. Accordingly, the Applicant respectfully requests that the rejection be withdrawn and the claims allowed.

CONCLUSION

In view of the above, it is clear that the grounds of rejection are deficient and improper for at least the reasons that (1) the Office Action fails to establish a prima facie case for rebutting the presumption that the written description requirement has been satisfied and (2) even if a prima facie case has been established, that the preponderance of the evidence shows that a person skilled in the art would readily recognize that the Applicant was in possession of the claimed subject matter at the time the application was filed. Accordingly, a panel decision that the rejections be withdrawn is earnestly solicited.

Respectfully submitted,

/Adam E. Crall/

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CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence, including any items indicated as attached or included, is being electronically submitted to the United States Patent & Trademark Office via the Electronic Filing System on the date indicated below.

Date: August 23, 2010

/Adam E. Crall/

Signature